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10/12/07

In re Application of:

Choe, Yun Soo, et al

Serial No.: 10/652,493

Filed: Sep. 2, 2003

Docket: 1670.1015

Title: HEATING CRUCIBLE FOR ORGANIC
THIN FILM FORMING APPARATUS

DECISION ON PETITION
under 37 CFR 1.181

This is a decision on the petition filed on Sept. 18, 2006 to request to the examiner's grounds of rejection in the Examiner's Answer of Jul. 24, 2007 be designated as a new ground of rejection raised for the first time in the Examiner's Answer.

The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is **GRANTED**.

In the petition, the petitioner requests the Office to issue a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the Technology Center 3700 Director or designee. In particular, the petitioner opines that the examiner's reliance on U.S. Patents to Colombo et al. (Colombo) (U.S. Patent No. 6,030,458), Yamashita et al. (Yamashita) (U.S. Patent No. 5,034,200), and Huthier et al. (Huthier) (U.S. Patent No. 4,511,612) to support the rejection of claims 1, 2, 4, 7, 9, 11-13, 16-18, 21-25, and 29-31 under 35 USC 103(a) as being unpatentable over Chow in view of Chandler or Isaacson clearly constitutes a new ground of rejection under the above guidelines set forth in M.P.E.P. § 1207.03 and § 1207.03(111).

Based on the record of the application, it appears to be the examiner's intention to cite three new references, U.S. Patents to Colombo, Yamashita and Huthier to support his rejection of the claims at issue and rebut the appellant's arguments raised in the Appeal Brief. The examiner particularly noted that "the new prior art patents are not applied in the ground of rejection, but they are listed under the section (8) Evidence Relied upon above in response to the applicant's newly raised argument in the brief that the pyrolytic boron nitride material shown in Chow is not a heat-resistant material. Contrary to the applicant's argument, these references show that the pyrolytic boron nitride materials are heat-resistant material." If the references in the final rejection of Oct. 12, 2006 are properly applied under 35 USC 103, then, it is not necessary to add these additional prior art references for further clarification and rebuttals in the Examiner's Answer. One skilled


in the art would have known what the physical and chemical properties of pyrolytic boron nitride material are. This is tantamount to citing the periodic chart when looking up for properties of elements. Therefore, the newly cited prior art patents to Colombo, Yamashita and Huthur should not have been added in the Examiner's Answer. If the newly cited prior art patents are necessary to understand and explain the rejection, then, the prior art patents must be applied against the claims under the rejection. Moreover, in the Examiner's Answer of Jul. 24, 2006, the examiner listed these three prior art patents to Colombo, Yamashita and Huthur under the Evidence Relied Upon section, which appears to be one of the prior art references against the claims under the rejection. By doing so, the addition of the Colombo, Yamashita and Huthur patents in the Examiner's Answer constitutes new ground of rejection.

In order to clear the record and comply with MPEP 1207, the Examiner is directed to: 1) vacate the Examiner's Answer of Jul. 24, 2007 and issue a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the Technology Center 3700 Director or designee as requested in the current petition; or 2) issue a revised Examiner's Answer without any reference to the newly cited prior art patents to Colombo, Yamashita and Huthur if the examiner believes the final rejection of Oct. 12, 2006 is proper and respond to the Reply Brief received on Sep. 18, 2007, if necessary. Under the circumstance, the examiner has the option to re-open prosecution if the newly cited prior art patents to Colombo, Yamashita and Huthur are used as prior art references against the claims.

Conclusion

In finding petitioner's points of argument persuasive, the requested relief is granted. The Examiner's Answer mailed on Jul. 24, 2007 is hereby vacated. The examiner has been directed to issue a corrected Examiner's Answer or new Office action not inconsistent with this decision. The application is being forwarded to the Art Unit 3742 further processing. Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION GRANTED

 10-12-07 for
Frederick R. Schmidt, Director
Technology Center 3700